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**NOV 14 2008**

In re Application of :  
KOYAMA et al. : LETTER REGARDING  
Application No. 10/629,108 : PATENT TERM ADJUSTMENT  
Filed: 07/28/2003 :  
Atty Docket No. 03338CIP/HG :

This is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 CFR §1.705)" filed May 8, 2008. Applicants request that the initial Determination of Patent Term Adjustment under 35 U.S.C. 154(b) be set at 259 days.

On February 20, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 177 days. On May 8, 2008, applicants filed the instant application for patent term adjustment. Applicants assert that the patent term should be adjusted by an additional 82 days for the Office's failure to respond to the Request for Continued Examination (RCE) of August 29, 2006, not later than four months after the date on which the reply was filed. See 37 CFR 1.702(a)(2).

Prior to the Office rendering a decision on the present application for patent term adjustment, applicants filed a petition to withdraw from issue, a RCE, and an Information Disclosure Statement on October 8, 2008. The application was withdrawn from issue and prosecution was reopened, as indicated by the decision mailed on October 14, 2008.

It is noted that applicants filed the instant application for patent term adjustment before the mailing of a new Notice of Allowance. It is further noted that an application for patent term adjustment under 37 CFR 1.705(b)<sup>1</sup> is properly filed after the mailing of the Notice of Allowance on which the application issues and prior to payment of the issue fee (or a request for reapplication of the issue fee) in response to that Notice.

In view thereof, a decision is being **held in abeyance** until after the mailing of any new Notice of Allowance and the filing (or resubmission) of any application for patent term adjustment under 37 CFR 1.705(b). A new determination of patent term adjustment will accompany any new Notice of Allowance and will include any further adjustments or reductions accrued to date.

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<sup>1</sup> As stated in 37 CFR 1.705(b) :

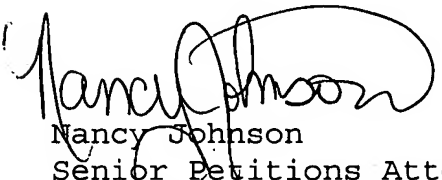
Any request for reconsideration of the patent term adjustment indicated in the notice of allowance, except as provided in paragraph (d) of this section, and any request for reinstatement of all or part of the term reduced pursuant to § 1.704(b) must be by way of an application for patent term adjustment. An application for patent term adjustment under this section must be filed no later than the payment of the issue fee but may not be filed earlier than the date of mailing of the notice of allowance. An application for patent term adjustment under this section must be accompanied by:

- (1) The fee set forth in § 1.18(e); and
- (2) A statement of the facts involved, specifying:
  - (i) The correct patent term adjustment and the basis or bases under § 1.702 for the adjustment;
  - (ii) The relevant dates as specified in §§ 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in § 1.703(f) to which the patent is entitled;
  - (iii) Whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer; and
  - (iv)
    - (A) Any circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704; or
    - (B) That there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

Applicants must review the determination of patent term adjustment at the time of mailing of the new Notice of Allowance and submit a new timely application for patent term adjustment in response to any new Notice of Allowance.<sup>2</sup> A copy of this decision should be included in any future request for reconsideration of the patent term adjustment, along with a request to apply the fee set forth in 37 CFR 1.18(e) paid on May 9, 2008.

Technology Center AU 2627 has been advised of this decision. The application is forwarded to the Technology Center 1625 for consideration of the RCE and the Information Disclosure Statement by the Examiner.

Telephone inquiries specific to this decision should be directed to Christina Tartera Donnell, Senior Petitions Attorney at (571) 272-3211.



Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

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<sup>2</sup> "Since the Office must complete its determination of patent term adjustment before proceeding to issue the patent (35 U.S.C. 154(b)(3)(D)), the Office must require that such application for patent term adjustment be filed within a non-extendable time period and set forth with particularity why the Office's patent term adjustment determination is not correct. In the absence of these requirements, the issuance of the patent will be further delayed by a protracted patent term adjustment determination proceeding." MPEP 2734.